IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#16

In re Application of:	)	
	)	
Elliot A. Gottfurcht, et al.	)	Examiner: Thomas J. Joseph
	)	
Serial No. 09/518,015	)	Art Group: 2174
	)	
Filed: March 3, 2000	)	
	)	
For: AN APPARATUS AND	)	
METHOD FOR SIMPLE WIDE-	)	
AREA NETWORK NAVIGATION	)	
	)	

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Technology Center 2100

REPY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants, (hereinafter "Appellants") submit, in triplicate, the following Reply Brief

pursuant to 37 C.F.R. § 1.193(b) for consideration by the Board of Patent Appeals and

Interferences. The Reply Brief is responsive to the Examiner's Answer.

I.   **ARGUMENT**

The Examiner has included additional points of argument in the Examiner's Answer regarding the obviousness rejections of claims 1, 6 and 25 over U.S. Patent No. 5,801,702 issued to Dolan, et al. (hereinafter "Dolan") in view of U.S. Patent No. 5,911,145 issued to Arora, et al. (hereinafter "Arora"), the obviousness rejection of claims 2, 7, 43 and 44 over Dolan in view of Arora and in further view of U.S. Patent No. 6,388,714 issued to Schein, et al. (hereinafter "Schein"), the obviousness rejection of claims 3-5 and 8-10 over Dolan in view of Arora and in further view of "Going from HTML to XML," Charles Heinemann, Microsoft Corporation (1998) (hereinafter "Heinemann") and U.S. Patent No. 6,418,441 issued to Call (hereinafter "Call"), the obviousness rejection of claims 23, 24, 26 and 27 over Dolan in view of Arora and in further view of U.S. Patent No. 6,476,875 issued to Croÿ, et al. (hereinafter "Croÿ") and the obviousness rejection of claims 28-38, 40-42, 47 and 48 over Dolan in view of Arora and in further view of U.S. Patent No. 6,460,181 issued to Donnelly (hereinafter "Donnelly"). In response to the additional arguments of the Examiner, the Appellants' Reply is set forth below:

A.   **Regarding the Examiner's Arguments for Claims 1, 6 and 25 Rejected Under 35 U.S.C. § 103**

The Examiner has responded to the Appellants' arguments present in Section VII.B of the Appeal Brief that Dolan teaches a hierarchy for accessing sites and that sites accessible from this hierarchy are considered sister sites. The Examiner's argument in response to the Reply Brief misses the fundamental thrust of the Appellants' arguments from the Appellants' Brief. The Appellants argued that Dolan and Arora were inappropriately combined. Dolan and Arora are inappropriately combined because their combination would change a basic operating principle of the primary reference (Dolan). The Examiner's response to the Appellants' argument is that because an HTML document is mentioned by Dolan, Dolan teaches an application for creating an

HTML document. The Examiner equates the existence of an HTML document with the generation of that document.

The Examiner's line of reasoning is irrelevant to the analysis of the proper combination of Dolan and Arora. The issue is not whether Dolan teaches the existence or even the creation of an HTML document, rather the issue is whether the combination of Arora which teaches a program for editing a hierarchical structure of a website with Dolan which teaches an application for creating a graphical tree of documents available on a network would change the basic operating principle of Dolan. As set forth in the Appeal Brief, Appellants believe that the basic operating principle of Dolan is the generation of a graphical hierarchy based on a navigation file where the generated graphical hierarchy is not a website. The combination of Dolan and Arora proposed by the Examiner is a modification of Dolan to make the graphical hierarchy into a website. Claims 1 and 6 include the elements of a simplified navigation interface that is for a webpage and provided by a sister site. The Examiner's proposed modification of Dolan to read upon these elements would change a basic principle of operation of Dolan from generating a graphical hierarchy based on a navigation file to somehow providing a sister site with this navigation hierarchy. However, the Examiner has not indicated how Arora teaches such a transformation.

The Examiner also states that Dolan teaches sister pages because Dolan teaches a hierarchy of accessible sites and that such sites accessible from this hierarchy are considered by the Examiner to be sister sites. The Examiner has elected to ignore the Appellants' arguments in the Appeal Brief setting forth what one of ordinary skill in the art would understand to be a "sister site." Rather, the Examiner has chosen to categorize documents listed in the graphical hierarchy of Dolan as sister sites without providing any rationale for this categorization.

Further, the Examiner has failed to address other arguments presented by the Appellants. Specifically, the Examiner has failed to identify what parts of Dolan teach or suggest each of the elements of claims 1 and 6, how Dolan can teach a sister site to webpage without teaching a webpage that links to a sister site (see page 4 of the Examiner's Answer) and how Dolan and Arora can be combined without changing the basic operating principle of Dolan. Accordingly, the

Examiner has failed to establish a *prima facie* case of obviousness and Appellants respectfully requests that the obviousness rejection be overturned for claims 1, 6 and 25.

B.   Regarding the Examiner's Arguments for Claims 2 and 7 Rejected Under 35 U.S.C. § 103

In the Examiner's Answer in regard to claims 2 and 7, the Examiner's further arguments have deviated from the relevant analysis. The relevant analysis is whether Schein combined with the other cited references teaches or suggests each of the elements of claims 2 and 7. The Examiner argues that Schein teaches a multi-layer matrix and an alphanumeric input. The Examiner has misunderstood the thrust of the Appellants' argument that Schein fails to teach accepting an *alphanumeric indication of a navigation option* that is displayed by a navigation interface and that the matrix layer that is served corresponds to the navigation option. The Examiner points to Figures 14C and 14D in Schein where a user is prompted for the entry of a password. This prompting problem does not involve the display of any navigation option and one of ordinary skill in the art would understand that a password is not an alphanumeric indication *of a navigation option*. Rather, a password is well known to be a security key for gating unauthorized access to materials not for indicating a navigation option. Thus, the entry of a password cannot be said to result in the serving of a matrix layer that corresponds to a navigation option as claimed in claims 2 and 7. Thus, the Examiner has failed to address the arguments presented by the Appellants and failed to establish the *prima facie* case of obviousness for claims 2 and 7. Accordingly, Appellants respectfully requests that the obviousness rejection of claims 2 and 7 be overturned.

C.   Regarding the Examiner's Arguments for Claims 43 and 44 Rejected Under 35 U.S.C. § 103

In the Examiner's Answer, the Examiner states that he is replying to the Appellants' arguments of the Appeal Brief in stating that "Schein teaches a simplified e-mail form (Figure 15B-15C)." Page 14, Paper No. 15. However, this is not in fact a response to the Appellants'

arguments, rather this is a restating of the rejection in the Final Office Action. Figures 15B and 15C of Schein show a system for viewing e-mail. As Appellants have set forth in Section VII.D of the Appeal Brief. This is not equivalent to teaching an e-mail form as claimed in claims 43 and 44. A form is "a document with blanks for the insertion of details or information." See the American Heritage Dictionary of the English Language, 4th Edition, Houghton Mifflin Company (2000). The viewer illustrated in Figure 15B and 15C does not include any blanks for the insertion of information and thus cannot be considered a form. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 43 and 44. Accordingly, Appellants respectfully request that the obviousness rejection of claims 43 and 44 be overturned.

D. **Regarding the Examiner's Arguments for Claims 3-5 and 8-10 Rejected Under 35 U.S.C. § 103**

In the Examiner's Answer, the Examiner states that approximating an HTML table in XML demonstrates that HTML pages can be transcoded to XML pages. One of ordinary skill in the art would understand that transcoding implies that the information or data in an original document is identical to that in a transcoded document and that only the format of representation of that data has changed. The Examiner admits that Heinemann only teaches an approximation of an HTML table in XML. Heinemann explicitly states that additional information is included in the XML document beyond what was included in the HTML document. See page 2 and 3 of Heinemann. Thus, the Examiner has not established that the cited references teach each of the elements of the claims. Therefor, the Examiner has failed to establish a *prima facie* case of obviousness for claims 3-5 and 8-10. Accordingly, Appellants respectfully request that the obviousness rejection of these claims be overturned.

E. **Regarding the Examiner's Arguments for Claims 23, 24, 26, and 27 Rejected Under 35 U.S.C. § 103**

In the Examiner's Answer, the Examiner states that Appellants have failed to provide additional support for overcoming the rejection of the Examiner. Appellants strongly disagree with

this statement. Appellants set forth in Section VII.F of the Appeal Brief the reasons that the Examiner has failed to substantiate the motivation for combining <u>Croÿ</u> with <u>Dolan</u> and <u>Arora</u>. The Examiner cites <u>Croÿ</u> to teach or suggest elements that the Examiner admits are not taught by <u>Arora</u> and <u>Dolan</u>. Thus, without providing proper motivation for the combination of <u>Croÿ</u>, <u>Dolan</u> and <u>Arora</u>, the Examiner has failed to establish a *prima facie* case of obviousness for claims 23, 24, 26 and 27. Accordingly, Appellants respectfully request that the obviousness rejection of these claims be overturned.

F. Regarding the Examiner's Arguments for Claims 28, 31, 32, 37 and 38 Rejected Under 35 U.S.C. § 103

In the Examiner's Answer, the Examiner states that the Appellants have failed to provide additional support for overcoming the Examiner's rejections. Appellants disagree. Appellants set forth the reasons in Section VII.G of the Appeal Brief that the cited references did not teach or suggest each of the elements of these claims. Specifically the cited references do not teach or suggest a webpage associated with a sister site for providing a simplified navigation interface for a webpage by a sister site. The Examiner has not responded to these arguments and thus has failed to establish a *prima facie* case of obviousness. Accordingly, it is respectfully requested that the obviousness rejection of claims 28, 31, 32, 37 and 38 be overturned.

G. Regarding the Examiner's Arguments for Claims 29 and 30 Rejected Under 35 U.S.C. § 103

In the Examiner's Answer, the Examiner mistates the Appellants' arguments as being based on the advertising of <u>Donnelly</u> not necessarily containing commercial content. In fact, the argument of the Appellants in the Appeal Brief in section VII.H is that the Examiner has failed to establish that commercial content is taught by <u>Donnelly</u> in a webpage that has an associated sister site that provides a simplified navigation for that webpage and that Donnelly has been improperly combined with <u>Dolan</u> and <u>Arora</u>. The Examiner has failed to respond to

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these arguments set forth in the Appeal Brief. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 29 and 30. Accordingly, Appellants respectfully request that the rejection of claims 29 and 30 be overturned.

H. Regarding the Examiner's Arguments for Claims 33, 34, 47 and 48 Rejected Under 35 U.S.C. § 103

In the Examiner's Answer, the Examiner states that Appellants have failed to provide additional support for overcoming the rejections of the Examiner. Appellants strongly disagree with this statement of the Examiner. In Section VII.I of the Appeal Brief, the Appellants have set forth their arguments that the Examiner has failed to establish that the cited references teach or suggest providing a second webpage associated with a sister site that provides a simplified navigation to the second webpage and that the Examiner's characterization of Donnelly in regard to these elements is inaccurate and inapposite for reading on the claims. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claims 33, 34, 47 and 48. Accordingly, Appellants respectfully request that the obviousness rejection of these claims be overturned.

I. Regarding the Examiner's Arguments for Claims 35 and 36 Rejected Under 35 U.S.C. § 103

In the Examiner's Answer, the Examiner argues that the EPG of Donnelly teaches providing button or icons for accessing various screens and programs. However, the Examiner has failed to address the core of the Appellants' argument that Donnelly does not teach or suggest the use of "primary navigation options" as claimed in claim 35 and 36. Primary navigation options are expressly defined in the specification as "navigation options that necessarily change between successive matrix layers, changing from general to more specific with increases in depth in the matrix." See page 16, line 17-19 of the specification. Thus, the Examiner has failed to establish that the cited references teach or suggest primary navigation options as defined in the specification and as used in claims 35 and 36. Therefore, the Examiner has failed to established a *prima facie*

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case of obviousness for claims 35 and 36. Accordingly, Appellants respectfully requests that the obviousness rejection of claims 35 and 36 be overturned.

J.   Regarding the Examiner's Arguments for Claim 39 Rejected Under 35 U.S.C. § 103

In the Examiner's Answer, the Examiner states that the Appellants have failed to provide additional support for overcoming the rejections of the Examiner. Appellants strongly disagree. Appellants have set forth the reasons in the section VII.K Appeal Brief that Dolan, Arora and Schein do not teach or suggest each of the elements of claim 39. In addition, Appellants have set forth the reasons that specific elements of claim 39, namely displaying purchasing information related to at least one item via a matrix layer are not taught by the cited references. In the Final Office Action, the Examiner cited a specific section of Dolan for teaching these elements of claim 39. However, the cited reference of Dolan does not discuss a matrix layer and therefore cannot teach displaying purchasing information related to at least one item as displayed *via* a matrix layer. The Examiner has failed to respond to this argument as set forth in the Appeal Brief. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claim 39. Accordingly, Appellants request that the obviousness rejection of claim 39 be overturned.

K.   Regarding the Examiner's Arguments for Claims 41 and 42 Rejected Under 35 U.S.C. § 103

In the Examiner's Answer, the Examiner states that Donnelly teaches searching without providing any additional support, citation or explanation for this assertion. In Section VII.L of the Appeal Brief, the Appellants set forth that the section cited in Donnelly in the Final Office Action has been reviewed but the Appellants have been unable to discern any part therein that discusses a search form. Further, the Examiner's argument that Donnelly teaches searching as inapposite. The Appellants claim a search *form* as part of a simplified navigation interface. Even accepting for the sake of argument that Donnelly teaches searching, this is insufficient to establish that Donnelly teaches a search form as part of a simplified navigation interface. The Examiner has failed to

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establish that <u>Donnelly</u> teaches a search form or that such search form is part of a simplified navigation interface. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 41 and 42. Accordingly, Appellants respectfully request that the Examiner's obviousness rejection of claims 41 and 42 be overturned.

L.   Regarding the Examiner's Arguments for Claims 45 and 46 Rejected Under 35 U.S.C. § 103

In the Examiner's Answer, the Examiner states that the Appellants have failed to provide additional support for overcoming rejections of the Examiner. Appellants disagree. The Appellants have set forth the reasons that <u>Dolan</u>, <u>Arora</u>, and <u>Schein</u> do not teach or suggest each of the elements of claims 45 and 46. In addition, the Appellants specifically set forth that the reasons that <u>Donnelly</u> does not teach or suggest providing a webpage associated with a sister site where that sister site provides a simplified navigation interface for the webpage, serving a matrix layer corresponding to a navigation option and accepting an alphanumeric indication of a navigation option displayed by the navigation interface. Therefore, the Examiner has failed to established a *prima facie* case of obviousness over <u>Dolan</u> in view of <u>Arora</u>, <u>Schein</u> and <u>Donnelly</u>. Accordingly, Appellants respectfully request that the obviousness rejection of claims 45 and 46 be overturned.

M.   Regarding the Examiner's Arguments for Claim 40 Rejected Under 35 U.S.C. § 103

In the Examiner's Answer, the Examiner states that the Appellants have failed to provide additional support for overcoming the Examiner's rejection. Appellants disagree. In section VII.N in the Appeal Brief, the Appellants set forth the reasons that <u>Dolan</u> in view of <u>Arora</u> and <u>Donnelly</u> does not teach or suggest each of the elements of this claim. In addition, the Appellants have set forth the reasons that <u>Donnelly</u> does not teach or suggest the display of purchasing information related to at least one item via a matrix layer. Appellants reviewed the cited section of <u>Donnelly</u> and are unable to discern any part therein that teaches or suggests displaying purchasing information regarding at least one item via a matrix layer. Thus, the Examiner has failed to establish a *prima*

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facie case of obviousness for claim 40. Accordingly, Appellants respectfully request that the obviousness rejection of claim 40 be overturned.

II.   CONCLUSION AND RELIEF

For the reasons specified above and in the Appellants' Appeal Brief, Appellants request that the rejection of all claims be overturned and that each claim currently pending be allowed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Dated: ___10/22___, 2003   _____Thomas Coester_____

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application No.	09/518,015
Filing Date	March 3, 2000
First Named Inventor	Elliot A. Gottfurcht
Art Unit	2174
Examiner Name	Thomas J. Joseph

Total Number of Pages in This Submission	14	Attorney Docket Number	4346P001X

ENCLOSURES *(check all that apply)*

☒ Fee Transmittal Form
  ☐ Fee Attached
☐ Amendment / Response
  ☐ After Final
  ☐ Affidavits/declaration(s)
☐ Extension of Time Request
☐ Express Abandonment Request
☐ Information Disclosure Statement
  ☐ PTO/SB/08
☐ Certified Copy of Priority Document(s)
☐ Response to Missing Parts/ Incomplete Application
  ☐ Basic Filing Fee
  ☐ Declaration/POA
  ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

☐ Drawing(s)
☐ Licensing-related Papers
☐ Petition
☐ Petition to Convert a Provisional Application
☐ Power of Attorney, Revocation Change of Correspondence Address
☐ Terminal Disclaimer
☐ Request for Refund
☐ CD, Number of CD(s)

☐ After Allowance Communication to Group
☐ Appeal Communication to Board of Appeals and Interferences
☒ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
☐ Proprietary Information
☐ Status Letter
☒ Other Enclosure(s) *(please identify below):*

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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Thomas M. Coester, Reg. No. 39,637 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	*Thomas Coester*
Date	October 22, 2003

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Typed or printed name	Lillian E. Rodriguez		
Signature		Date	October 22, 2003

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FEE TRANSMITTAL
for FY 2003
Effective 01/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT	($)	0.00

Complete if Known

Application Number	09/518,015
Filing Date	March 3, 2000
First Named Inventor	Elliot A. Gottfurcht
Examiner Name	Thomas J. Joseph
Group/Art Unit	2174
Attorney Docket No.	4346P001X

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METHOD OF PAYMENT *(check all that apply)*

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☒ None
☐ Deposit Account

Deposit Account Number: 02-2666

Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP

, The Commissioner is authorized to: *(check all that apply)*

☐ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Fee ($)	Small Entity Fee Code	Fee ($)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) ($)

2. EXTRA CLAIM FEES

	Extra Claims	Fee from below	Fee Paid
Total Claims	48 - 48 = 0	X 9.00 =	$0.00
Independent Claims	4 - 4 = 0	X 43.00 =	$0.00
Multiple Dependent		=	

Large Entity Fee Code	Fee ($)	Small Entity Fee Code	Fee ($)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple Dependent claim, if not paid
1204	86	2204	43	**Reissue independent claims over original patent
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($) 0.00

*or number previously paid, if greater, For Reissues, see below

FEE CALCULATION (continued) OCT 30 2003

3. ADDITIONAL FEES

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Large Entity Fee Code	Fee ($)	Small Entity Fee Code	Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
2053	130	2053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for *ex parte* reexamination	
1804	920 *	1804	920 *	Requesting publication of SIR prior to Examiner action	
1805	1,840 *	1805	1,840 *	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	1,210	2255	605	Extension for reply within fifth month	
1404	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	1809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($)

SUBMITTED BY

				Complete (if applicable)	
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Signature	*Thomas Coester*			Date	10/22/03